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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,605	07/09/2001	Kenneth F. Pearce	2001KP246PA	4114

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EXAMINER

BOVEJA, NAMRATA

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/900,605		PEARCE, KENNETH F.	
	Examiner		Art Unit	
	Namrata Boveja		3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 06/19/2006.
2. Claims 25-49 are presented for examination.
3. Amendments to claims 26 and 43 have been entered and considered.
4. Typographical error made in the rejection for claims 38 and 47 has been corrected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 25-49 are rejected under U.S.C. 103(a) as being anticipated by the article by Ralph Ruton titled "What's in a name? Another paid ad" from the Colorado Springs Gazette on July 1, 1989 on page C.1. (hereinafter Ruton) in view of Gershon Patent Number 6,257,984 (hereinafter Gershon) further in view of Official Notice.

In reference to claims 25 and 32, Ruton teaches a method for face-to-face advertising comprising the steps of: a) arranging for payment from an advertiser prior to wearing a headdress (i.e. sponsor's agree to pay athletes including golfers \$100,000 for wearing a visor with a sponsor's name or logo during a game) (page 1 lines 1-3 and page 2 lines 34-36); b) wearing a headdress for displaying messages in a public place (i.e. pro-golfers wear the visors during games in public with corporate logos) (page 1

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lines 1-3 and page 2 lines 34-36); and c) moving said headdress about said public place (i.e. pro-golfers wear the visors during games in public with corporate logos and become walking billboards for advertising) (page 1 lines 1-3 and page 2 lines 34-36).

Routon does not teach displaying electronic messages. Gershon teaches displaying electronic messages (i.e. a video game, images, horoscope, reports, and other information of interest to a user) on a hat (col. 2 lines 6-34 and Figures 3 and 5). It would have been obvious to modify Routon to include displaying electronic messages, because electronic messages can be changed more frequently and can be more colorful and visually appealing to the users.

Routon also does not teach the headdress to include more than one screen or five planes for displaying said electronic messages. Official Notice is taken that it is old and well known to use multiple screens or planes for viewing different content simultaneously, since one person may be interested in one message and another in a different message that are displayed on different screens. Additionally, users may need to use multiple screens or planes to view an illustration and text simultaneously. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include more than one screen or plane for displaying electronic messages to cater to a wide variety of audience members and to provide two forms of information (i.e. a graphic and text for example) at the same time to the users.

6. In reference to claim 41, Routon teaches a method for face-to-face advertising comprising the steps of: a) arranging for payment from an advertiser prior to wearing a headdress (i.e. sponsor's agree to pay athletes including golfers \$100,000 for wearing a

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visor with a sponsor's name or logo during a game) (page 1 lines 1-3 and page 2 lines 34-36); b) wearing a headdress for displaying messages in a public place on a message board (i.e. the area of the headdress where the advertisement is displayed is the board containing the message or a message board) wherein said headdress further comprises a visor or a brim (i.e. pro-golfers wear the visors during games in public with corporate logos) (page 1 lines 1-3 and page 2 lines 34-36); and c) moving said headdress about said public place (i.e. pro-golfers wear the visors during games in public with corporate logos and become walking billboards for advertising) (page 1 lines 1-3 and page 2 lines 34-36).

Routon does not teach displaying electronic messages. Gershon teaches displaying electronic messages (i.e. a video game, images, horoscope, reports, and other information of interest to a user) on a hat (col. 2 lines 6-34 and Figures 3 and 5). It would have been obvious to modify Routon to include displaying electronic messages, because electronic messages can be changed more frequently and can be more colorful and visually appealing to the users.

Routon also does not teach the headdress to include more than one message board for displaying said electronic messages. Official Notice is taken that it is old and well known to use message boards for viewing different content simultaneously, since one person may be interested in one message and another in a different message that are displayed on different message boards. Additionally, users may need to use multiple message boards to view an illustration and text simultaneously. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's

invention to include more than one message board for displaying electronic messages to cater to a wide variety of audience members and to provide two forms of information (i.e. a graphic and text for example) at the same time to the users.

Routon also does not teach the headdress to be cubic shaped. Official Notice is that it is old and well known to use cubic shaped headdresses (i.e. a cubic shaped hat as worn by Dr. Seuss's character in the book "The Cat in the Hat" and by clowns). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of a cubic shaped headdress, since this type of a hat is taller and more visible in public, it would therefore attract more attention to the advertising message that is being displayed on the hat.

7. **Disclaimer:** Claim 26 was found be deficient under U.S.C. 112. To the extent it was understood, it has been examined.

In reference to claim 26, Routon teaches displaying messages on a headdress (page 1 lines 1-3 and page 2 lines 34-36), but does not teach the displaying electronic messages *as directed by a controller*. Loban et al. Patent Number 5,612,741 (hereinafter Loban) teaches displaying said electronic messages *as directed by a controller* (col. 1 lines 42-49, col. 3 lines 3-15, and col. 4 lines 54-65). It would have been obvious to modify Routon to include displaying electronic messages *as directed by a controller*, because electronic messages can be changed more frequently in real time and can thereby be more colorful and visually appealing to users and more valuable to advertisers *as controlled by the controller*, since *the advertisers* can pick the day, the

time, and the message to display to enable for a customized advertising solution *and the controller can display the messages according to advertiser specifications.*

8. In reference to claim 27, Routon teaches attaching a brim or a visor (page 1 lines 1-3 and page 2 lines 34-36) to the said headdress.

9. In reference to claims 28, 29, 35, and 44, Routon does not teach altering one or more of the said electronic messages according to a predetermined paradigm (i.e. model, pattern, example, or assumption). Gershon teaches altering one or more of the said electronic messages according to a predetermined paradigm (i.e. the push button operation by the user leads to changing imagery or content in the video game, in a horoscope, or in news reports, etc.) (col. 2 lines 6-25 and Figure 5). It would have been obvious to modify Routon to include displaying electronic messages according to a predetermined paradigm, because electronic messages can be changed more frequently and can be more colorful and visually appealing to the users. Furthermore, the predetermined paradigm such as what happens when the user presses a specific button when playing a game versus viewing a news report, allows for consistency between different users who may operate the electronic display to view different types of content.

10. In reference to claims 30, 40, and 49, Routon does not teach displaying one or more of said electronic messages for a predetermined time before displaying one or more different messages for a predetermined time. Loban teaches displaying one or more of said electronic messages for a predetermined time before displaying one or more different messages for a predetermined time (col. 1 lines 45-49, col. 3 lines 12-15,

and col. 4 lines 60-65). It would have been obvious to modify Routon to include displaying electronic messages displaying one or more of said electronic messages for a predetermined time before displaying one or more different messages for a predetermined time, because electronic messages can be changed more frequently in real time and can thereby be more colorful and visually appealing to users and more valuable to advertisers, since they can pick the day, the time, and the message to display to enable for a customized advertising solution.

11. In reference to claim 31, Routon teaches incorporating an advertiser's registered trademark (i.e. a sponsor's name or logo) into one or more messages (page 1 lines 1-3 and page 2 lines 34-36). Routon does not teach displaying electronic messages. Gershon teaches displaying electronic messages (i.e. a video game, images, horoscope, reports, and other information of interest to a user) on a hat (col. 2 lines 6-34 and Figures 3 and 5). It would have been obvious to modify Routon to include displaying electronic messages, because electronic messages can be changed more frequently and can be more colorful and visually appealing to the users.

12. In reference to claims 33 and 42, Routon does not teach ordering (i.e. which one to show, when, and for how long) said electronic messages for public display. Loban teaches ordering said electronic messages for public display (col. 1 lines 31-49 and col. 3 lines 3-15). It would have been obvious to modify Routon to include displaying electronic messages in an ordered fashion, because electronic messages can be changed more frequently and can be more colorful and visually appealing to the users

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and can cater to more than one advertiser at a time by displaying multiple ordered messages.

13. In reference to claims 34 and 43, Routon teaches the method wherein said electronic messages are controlled by a controller (i.e. the buttons on the hat that control the display to show video games, horoscopes, news reports, and other information) preprogrammed with advertising messages (col. 2 lines 6-44 and Figure 5), prior to wearing said headdress in said public place (i.e. the buttons can work before and after wearing the hat) (col. 2 lines 6-44 and Figure 5), and wherein said controller is *attached to the headdress* (i.e. the controller is located on the hat itself) (col. 2 lines 6-44 and Figure 5).

14. In reference to claims 36 and 45, Routon teaches wearing the headdress in a public place (page 1 lines 1-3 and page 2 lines 34-36). Routon does not teach the method wherein said electronic messages are controlled by a controller receiving one or more signals generated from a location remote from the said headdress. Loban teaches the method wherein said electronic messages are controlled by a controller receiving one or more signals generated from a location remote from the said headdress (col. 1 lines 31-49, col. 2 lines 64 to col. 3 lines 14, and col. 4 lines 54-65). It would have been obvious to modify Routon to control electronic messages by a controller receiving one or more signals generated from a location remote from the said headdress, because this would provide flexibility to advertisers by enabling them to change content at a moment's notice remotely and conveniently without having to physically go to the message board to make changes.

15. In reference to claims 37, 39, 46, and 48, Routon does not teach the method further comprising the step of altering one or more of said electronic messages according to said one or more signals (i.e. an advertiser wants to show a different advertisement and sends a signal for the display of this new advertisement). Loban teaches the method further comprising the step of altering one or more of said electronic messages according to said one or more signals (col. 1 lines 39-42, col. 2 lines 64-67, and col. 4 lines 54-65). It would have been obvious to modify Routon by altering one or more of said electronic messages according to said one or more signals in order to provide more control and flexibility for the advertisers to change the displayed advertisements quickly and easily by simply sending a signal requesting the change.

16. In reference to claims 38 and 47, Routon teaches wearing the headdress in a public place (page 1 lines 1-3 and page 2 lines 34-36). Routon does not teach the method wherein said electronic messages are controlled by a memory programmed with advertising messages, until said memory receives one or more signals, generated from a location remote from said headdress, for altering said advertising messages. *Loban teaches the method wherein said electronic messages are controlled by a memory programmed with advertising messages, until said memory receives one or more signals, generated from a location remote from said headdress, for altering said advertising messages (col. 2 lines 64 to col. 3 lines 15).*

It would have been obvious to modify Routon to include the method wherein said electronic messages are controlled by a memory programmed with advertising

messages, until said memory receives one or more signals, generated from a location remote from said headdress, for altering said advertising messages in order to display different messages on the headdress and to easily retrieve the messages themselves for the display in an efficient way.

Response to Arguments

17. After careful review of Applicant's remarks/arguments filed on 06/19/2006, the examiner fully considered the arguments, but they are not persuasive.

18. Applicants amendment for claims 26 and 43 addressed the rejection made under 35 USC § 112, and this rejection has therefore been removed.

19. In reference to claims 25, 32, and 41, the Applicant demands the production of documentary evidence to support the rejection of any claim based in whole or in part on Official Notice. Applicant further argues that the Examiner has acted arbitrarily and capriciously or both in rejecting these claims, because according to the Applicant, the Examiner has failed to produce any evidence and does not pass muster under *Dickenson v. Zurko*. Applicant states that the Examiner veiled the 35 U.S.C. § 103 rejections in the cloak of Official Notice. With respect to this, the Examiner would like to point out that the Applicant has not presented arguments that the features of having one or more screens (or planes) for displaying electronic messages are not well known. The Applicant's only argument has been that the Examiner has acted arbitrarily and capriciously or both in rejecting these claims, because according to the Applicant, the Examiner has failed to produce any evidence and does not pass muster under *Dickenson v. Zurko* and that the Examiner veiled the 35 U.S.C. § 103 rejections in the

cloak of Official Notice. This does not constitute a proper challenge to the Official Notice, since the Applicant has not said anything regarding that the Applicant was not aware that the claimed elements were well known before the filing of his application and before his invention was developed. Per the Applicant's citing of MPEP 2144.03, "A seasonable challenge constitutes a demand for evidence be made as soon as practicable during prosecution. Thus the applicant is charged with rebutting the well known statement in the next reply after the Office Action in which the well known statement was made." The Applicant has not submitted any rebuttal of the well-known statements. In the paragraph in MPEP 2144.03 immediately preceding the above citing, reference is made to *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970) that "Furthermore, the applicant must be given the opportunity to challenge the correctness of such assertions and allegations." Again, the Applicant has not challenged the correctness of the assertions but rather only the use of Official Notice itself. Bald statements such as "the Examiner has acted arbitrarily and capriciously" "the Examiner has failed to produce any evidence" and that "the Examiner veiled the 35 U.S.C. § 103 rejections in the cloak of Official Notice" are not adequate and do not shift the burden to the examiner to provide evidence in support of the Official Notice.

Allowing such statements to challenge Official Notice would effectively destroy any incentive on part of the Examiner to use it in the process of establishing a rejection of notoriously well known facts (*In re Boon*, 169 USP 231 (CCPA 1971). Furthermore, the Examiner had previously cited two examples to support the Official Notice including the use of multiple screens to display different content simultaneously (i.e. at an airport

multiple screens to display content simultaneously can be found to display information by time, arrival, departure, and the airline carrier) and for showing text on one screen and graphics on another. Therefore, the Official Notice is proper and fully supported by the indicated evidence and is maintained.

20. In reference to claims 25 and 32, the Applicant argues that the Examiner did not provide a workable logical reason to utilize the teachings of Routon in combination with Gershon to make the Applicant's invention, and that neither of the two references teach or suggest the Applicant's invention and there is no motivation for combining the two references. First of all, it is unclear if the Applicant does not agree that the motivation is good or if the Application's does not agree that there is a motivation to combine the references. Routon has an advertisement on a hat and paying for the advertisement, but it's not an electronic advertisement. Gershon has an electronic display on a hat where the display features images, video games, horoscope, and weather, and so it has the features of a hat that displays messages for someone to look at. An advertisement is a message that the advertisers want people to look at. The only thing that's different in Gershon is therefore the type of message, and even with this, an image can be an advertisement, since people want to look at an image just like people look at an advertisement, and image can be a company logo for example. There is motivation to combine the two references because they both pertain to hats with advertisements and images (i.e. a logo can be an advertisement or just an image), and the displaying of advertisements electronically as indicated before can enable the changing of the messages more frequently and enhancing the appearance of the messages through the

use of a colorful and visually appealing display. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, obviousness is established by combining Gershon's teachings with the motivation found in the knowledge generally available to one of ordinary skill in the art. Specifically, it would be obvious to utilize an electronic display on hats to make the messages easy to change, colorful, and visually appealing as done by the message boards at a ball game for example to capture the attention of crowds. Furthermore, Gershon also teaches displaying electronic images on the hat, and these images could consist of logos etc. Therefore, motivation can indeed be found in the prior art and in the knowledge generally available to one of ordinary skill in the art.

21. In reference to claim 41, Applicant argues that the Examiner has acted arbitrarily and capriciously in rejecting these claims, because according to the Applicant, the rejection does not pass muster under *Dickenson v. Zurko*, Google image search record did not yield any cubic shaped hats. While it may be true that cubic shaped hats are not prevalent, Examiner asserts that the "The Cat in the Hat" displayed on page 2 of Applicant provided Google search is interpreted to resemble a cubic shaped hat. Applicant did not specify the dimensions of a cubic shaped hat, and the Applicant fails

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to demonstrate what if any is the functional difference resulting from the shape of the hat. Furthermore, according to *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int 1961) according to which, as to the rejection of the claims on the prior art references, the Examiner does not agree with the Applicant that such structural limitations not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. **To be entitled to such weight in method claims**, the recited **structural limitations** therein **must affect the method** in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in the Examiner's opinion, is the case here.

22. In reference to claim 26, the applicant argues that the size of the cathode ray tube used in the Loban would be too big and unsafe for use on a headdress and deals with electronic billboards instead. The Examiner would like to clarify to the Applicant that the purpose of the Loban reference is to demonstrate that it is known to display different content on an electronic display to have different sponsors pay for the displayed content. The point is that this changing of content on the display is known. Therefore, it would be obvious to do change the display in Routon to an electronic display with contents that can be changed as directed by the controller so that revenues can be collected from the different advertisers for the display of their respective content. And this is why there is a proper motivation to combine the two references.

23. Applicant argue that claims 38 and 47 did not indicate any reference the Examiner would combine with Routon and while Applicant correctly suspected that the Examiner may have meant Loban as the reference, it is arbitrary and capricious to

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require Applicant to respond to an unknown reference. While the Examiner agrees with the Applicant that claims 38 and 47 did not indicate Loban as the secondary reference even though it did indicate the location in Loban (col. 2 lines 64 to col. 3 lines 15) in the body of the rejection in the previous Office Action, this is was an oversight by the Examiner, and the subject matter contained in claims 38 and 47 has been sufficiently addressed previously in claims 36 and 45. Specifically, claims 36 and 45 recite the limitation, wherein said electronic messages are controlled by a controller receiving one or more signals generated from a location remote from the said headdress which was identified to be found in Loban (col. 1 lines 31-49, col. 2 lines 64 to col. 3 lines 14, and col. 4 lines 54-65). And, claims 38 and 47 recite this same limitation.

24. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Point of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).



NB

September 1st, 2006



RETTA YEHDEGA
PRIMARY EXAMINER